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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/604,157 06/27/00 BESSETTE

S 45112-081

EXAMINER

HM12/1009

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LEVY, N

ART UNIT

PAPER NUMBER

1616

DATE MAILED:

10/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

604157

Applicant(s)

Bessette

Examiner

MGT Lery

Group Art Unit

1616

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Priority Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 3/24/01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-7 is/are pending in the application.
- Of the above claim(s) 4-6 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-3, 2 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-7 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 7
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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Receipt is acknowledged of declaration and IDS (3/22/01).

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, 7, drawn to contact composition, classified in class 424, subclass 405.
- II. Claims 4-6 are, drawn to fumigant, classified in class 424, subclass 45.

The inventions are distinct, each from the other because:

The products of Group I are independent and patentably distinct from those of Group II, and are useful in different methods, such as crop sprays as opposed to household use:

This application contains claims directed to the following patentably distinct species of the claimed invention: species of essential oil, as of claim 3 or 6.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-7 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Attorney William Gadiano on 9/19/01 a provisional election was made with traverse to prosecute the invention of contact poisons, claims 1-3 and 7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4-6 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"Derivative" is indefinite--is carbon dioxide or water intended? "Acceptable" is indefinite--to whom? How?

Parentheses should not be used in claims. What are the V-compounds--if trade names, please identify generically; actually, structurally, and provide RN, CAS numbers.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 1-3, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Pallaske et al DE 4231045; Jumo--JP 10203918 Abstract or Sugiura et al JP 08119819 *sh Lin*

Pallaske: See Fig. The instant essential oils are pesticidally effective, unacceptable carriers (col. 3).

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Lin: See abstract: carriers include (p. 461) silica, Eugenol and (abstract) the essential oils of Cinnamomum leaves--as actives, eugenol, cinnamaldehyde.

Jumo: derivatives of the instant essential oils with aqueous surfactant carrier control termites.

Sugiura: essential oils acceptable carriers, contain the instant derivatives and are pesticidal to termites.

Claims 1-3, 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Sharma et al '94.

Terpenoids and essential oils are effective for termite control (Table 2), and can be incorporated in acceptable carriers to be placed at the locus of the desired control (last paragraph).

Claims 1-3 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Dow et al--1514377.

Acceptable vehicles for benzyl alcohol are shown (col. 1, last paragraph, col. 2, top of page 1). It is applied to the locus where protection is desired--(col. 1, lines 25-33) happens to be trees, inherently protection from tree eaters, termites, would occur, as they are insects.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Yang--4446153 .

See claims: acceptable carrier and benzyl.

Alcohol: claim 1, if present, termites inherently would be controlled.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is (703) 308-2412. The examiner can normally be reached on Tuesday to Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached on (703) 308-4628. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Levy:mv

September 25, 2001



NEIL S. LEVY  
PRIMARY EXAMINER